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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,815	09/25/2003	Paul Moulton	A35985 - 070121.0573	7621
21003 7590 03/07/2007 BAKER & BOTTS L.L.P. 30 ROCKEFELLER PLAZA 44TH FLOOR NEW YORK, NY 10112-4498			EXAMINER HORTON, YVONNE MICHELE	
			ART UNIT 3635	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/07/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/670,815

Applicant(s)

MOULTON ET AL.

Examiner

Yvonne M. Horton

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8, 10, 12-15, 17-38 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 32 and 33 is/are allowed.
- 6) ☐ Claim(s) 2-8, 10, 12-15, 17-31, 34-38 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Attachment

DETAILED ACTION

Status of the Claims

Claims 1,9,11,16,39,40 have been cancelled and claims 2-8,10,12-15,17-38 and 41 await an action on the merits.

Withdrawal of Allowable Subject Matter

The indicated allowability of claims 22,34-36,38 and 41 is withdrawn in view of a more thorough review of the reference(s) to HARTKORN. Rejections based on the newly cited reference(s) follow.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "notches or cuts" and the "detached or discontinuous segments" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

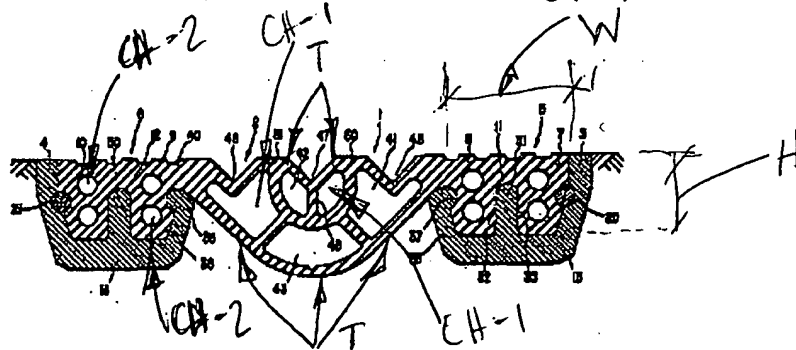
Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

larger block out widths ease placement of the smaller lateral wings during placement of the compression seals. The specification does not detail the specifics of the width and length of the lateral wings or reasons for the length being "substantially" larger than the width.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,2,5-8,10,26,30 stand and 38,40 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #4,637,085 to HARTKORN. Regarding claims 1,38 and 40, HARTKORN discloses the use of a compression seal for an expansion joint (1) between two adjacent elements (15,16) including a compressible sealing portion (2) having an elastic membranes (T,48) and at least a lateral wing (5,6)



extending therefrom and extruded as one-piece therewith; wherein the lateral wings, have a width (W) and a height (H) such that the width (W) is larger than the height (H) and a thickness (TH) that is larger than the thickness of the elastic membranes (T,48) and are configured to be bonded to a surface of the adjacent elements (15,16).

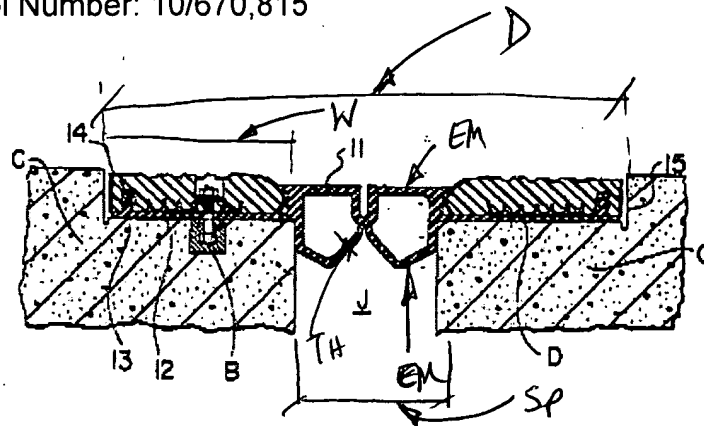
Regarding the 35 U.S.C.112 rejections above, the applicant has shown no criticality for the length of the lateral wings being 'substantially' larger than the width of the wings.

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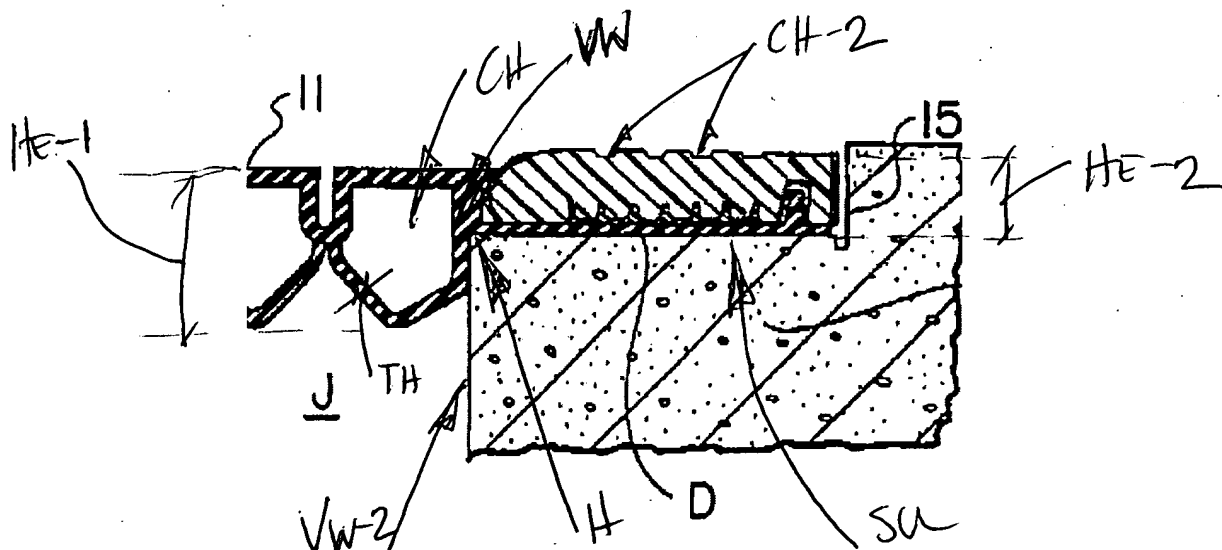
attention is brought to the fact that ***bonded***, as defined by Random House New Collegiate Dictionary (see attachment) *means to bind, fasten or confine*. Clearly, the portions (20,21) and by (30,31) and (37,38) of HARTKORN at least binds, fastens and confines the lateral wings (5,6) within members (15,16) and indirectly to surfaces (TA). In reference to claim 2, HARTKORN discloses that his wings (5,) have a thickness of 3.5 cm that converts to 1.37 inches which is at least a half of an inch. Regarding claims 5 and 6, the compressible sealing portion (2) includes a membrane having longitudinal tubes/channels (as at 41,42) that extends along the length thereof and are inherently known to aid in varying the lateral width of the member. Regarding claims 7 and 8, the lateral wing portion (5,6) includes longitudinal channels (CH-2) and grooves (as at 40). In reference 10, the compressible seal of HARTKORN has the same cross-sectional configuration throughout. Regarding claims 26 and 27, as mentioned earlier, the "tubes/channels" (as at 41,42) inherently change or deform in order to vary the lateral width of the compressible sealing portion (2).

Claims 12,15,17-24,28,29,35,36,38 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,584,152 to BAERVELDT. Regarding claim 35, 36,38 and 41, BAERVELDT discloses the use of an expansion joint system including an expansion joint spacing (SP) between two adjacent concrete elements (C); a one-piece compression seal (11) having elastic membranes (EM) and at least a lateral wing (1) extending therefrom and extruded as one-piece therewith; wherein the lateral wings (1) have a thickness (W) larger than a thickness (TH) of the elastic membranes (EM)

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and grooves (7,8) bonded to a block-out region (D) adjacent the concrete elements (C) such that the lateral wings (1) are received therein and the compressible sealing portion (11) is inserted in the expansion joint spacing (SP). The applicant's attention is brought to the fact that **bonded**, as defined by Random House New Collegiate Dictionary (see attachment) means to bind, fasten or confine. Clearly, the portions (12,16) and by (B) of BAERVELDT at least binds, fastens and confines the lateral wings (1) within (D). Further regarding claims 22,35 and 36, the lateral wing (1) has a surface (12,16) is bonded to a surface (SU,15) of the block-out region (D) and the lateral wing (1) being



formed of a durable rubber material is inherently flexible and able to hinge as at (H).

And with further reference to claims 38 and 41, the height (HE-1) of the compressible

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sealing portion is substantially larger than the height (HE-2) of the lateral wings (1). In reference to claim 12, the depth of the block-out (D) is about the same as the thickness (W) of the lateral wings (1). Regarding claim 15, the lateral wing (1) is bonded to the block-out region (D) by an anchoring bolt (B). In reference to claims 17 and 18, the one-piece compression seal (11) is made from an extruded polyethylene or propylene rubber. Although BRAERVELDT does not explicitly detail EPDM, extruded polyethylene or polypropylene, in trade, are inherently known as EPDM rubbers. Regarding claims 19,20,28 and 29, the compressible sealing portion (11) is a membrane that includes longitudinal tubes/channels (CH) inherently deform to allow the compressible sealing portion (11) to vary in lateral width. In reference to claim 21, the lateral wings (1) include channels (CH-2). Regarding claim 23, the compressible seal (11) of BAERVELDT has the same cross-sectional configuration throughout. In reference to claim 24, the adjacent concrete elements (C) have a floor slab (SU) and a vertical wall (15), and the compressible sealing portion (11) has a substantially vertical wall (VW) that is bonded (as by through use of a narrow sealant) to the vertical wall (VW-2) of BAERVELDT, column 3, lines 40-45.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3 and 4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #4,637,085 to HARTKORN in view of US Patent #5,213,441 to BAERVELDT. HARTKORN discloses the basic claimed compression seal except for

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explicitly detailing the type of rubber material used to form the seal. BEARVELDT teaches that it is known in the art to use an extruded polyethylene or propylene rubber. Although BRAERVELDT does not explicitly detail EPDM, extruded polyethylene or polypropylene, in trade, are very well known in the art as EPDM rubbers. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the member of HARTKORN out of EPDM rubber, as taught by BAERVELDT, in order to have an expansion member that is durable yet capable of deforming, has a high density thus transfers forces well, and is weather and wear resistant.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,213,441 to BAERVELDT. BAERVELDT discloses the basic claimed compression seal except for explicitly detailing the length of the lateral wings. Although BAERVELDT is silent in this regard, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known wing length suitable for the size of the block-out as an obvious matter of design choice. For instance, if the design requires a tighter fit of the expansion member between the concrete members perhaps a much larger lateral length would be used because it would cause the expansion joint to fit more snug therein. However, if the design does not require a tight fit a wing length that comfortably seats within the block-out region would prove profitable.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,213,441 to BAERVELDT in view of US Patent #4,932,183 to COULSTON.

BAERVELDT discloses the basic claimed compression seal except for explicitly detailing that the lateral wings are bonded using an adhesive. COULSTON teaches that it is known in the art to use an adhesive (34) to bond the lateral wings (12) of an expansion joint member (10) to a surface (22,24). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the expansion joint member of BAERVELDT with the adhesive of COULSTON in order to provide the system with added strength and rigidity thereby enabling the system of BAERVELDT to withstand larger forces and to have more wear resistance.

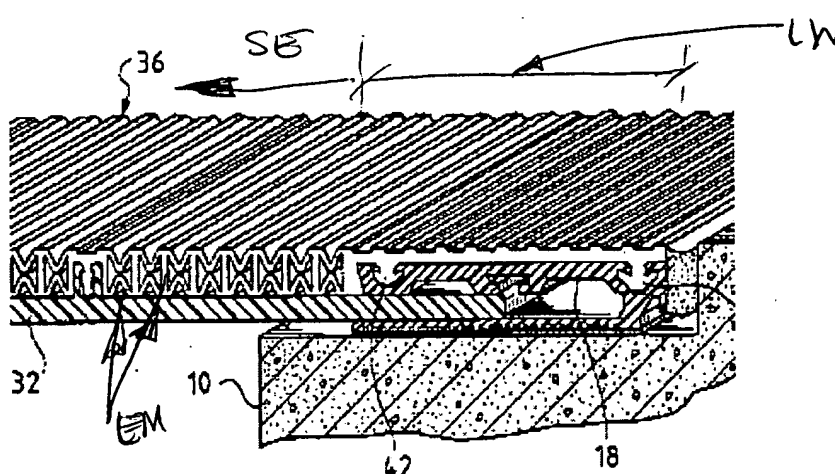
Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,213,441 to BAERVELDT in view of US Patent #5,887,400 to BRATEK et al. BAERVELDT discloses the basic claimed system except for concrete slab and compressible seal portion having vertical and horizontal portions or sections and except for the lateral wings being discontinuous. With reference to the vertical and horizontal portions or sections, BRATEK et al. teaches the use of a concrete area (10,12) is stepped having a horizontal step portion (HP) and a vertical riser portion (VR) such that the one-piece compression seal (SE) includes a horizontal (HZ) and a vertical section (VS) bridging; respectively, the horizontal step portion (HP) and the vertical riser portion (VR). Although BRATEK et al. does not detail the use of a discontinuous lateral wing, it would have been obvious to one having ordinary in the art at the time the invention was made to form the concrete and compressible seal portion of BAERVELDT as having vertical and horizontal portions or section, as taught by BRATEK et al. in order to create a system that is much more versatile and able to be used in a number of areas including

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #4,637,085 to HARTKORN in view of US Patent #4,932,183 to COULSTON. HARTKORN discloses the basic claimed compression seal except for explicitly detailing that the lateral wings are bonded using an adhesive. COULSTON teaches that it is known in the art to use an adhesive (34) to bond the lateral wings (12) of an expansion joint member (10) to a surface (22,24). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the expansion joint member of HARTKORN with the adhesive of COULSTON in order to provide the

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system with added strength and rigidity thereby enabling the system of HARTKORN to withstand larger forces and to have more wear resistance.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over US patent #5,887,400 to BRATEK et al. BRATEK et al. discloses the use of an expansion joint system including an expansion joint spacing (SP); a one-piece compression seal (36) including a compressible sealing portion (SE) made up of elastic membranes (EM)



and lateral wings (LW); wherein the lateral wings (LW) have a thickness that is larger than a thickness of the individual elastic membranes (EM); and a block-out region between the areas (14, 16) wherein the adjacent concrete area (10, 12) is stepped having a horizontal step portion (HP) and a vertical riser portion (VR) such that the one-piece compression seal (SE) includes a horizontal (HZ) and a vertical section (VS) bridging; respectively, the horizontal step portion (HP) and the vertical riser portion (VR). BRATEK et al. discloses the basic claimed system except for the lateral wings being discontinuous. Although BRATEK et al. does not detail the use of a discontinuous lateral wing, it would have been obvious to one having ordinary in the art at the time the invention was made to form the lateral wings of BRATEK et al. into several elements

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since it is known to form that which was previously known as being formed in one-piece since it is within general skill of a worker in the art.

Allowable Subject Matter

Claims 32 and 33 remain as being allowed.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the newly revised ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Yvonne M. Horton
Examiner
Art Unit 3635

01/18/07

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-aceae -ACEAE + -ous]

bonbard (n. bom bard'; n. bom/bard), *v.t.* 1. to attack

or batter with artillery fire. 2. to assail vigorously: to bomb-

bard someone with questions. 3. Physics. to direct high

energy particles or radiations against: to bombard a nucleus.

—n. 4. the earliest kind of cannon, originally throwing stone

balls. [ME < ML bombard(a) stone-throwing engine = L

bomb(us) booming noise (see bomb) + -arda -ard] —bom-

bard'er, n. —bom-bard/ment, n.

bom-bardier (bom/bard'ier), n. 1. Mil. the member of

a bomber crew who operates the bombsight and bomb-

release mechanism. 2. Hist. artilleryman. [*< MF*]

bom-bast (bom/bast), n. 1. pretentious words; speech

too pompous for an occasion. 2. Obs. cotton or other

material used to stuff garments; padding. —adj. 3. Obs.

bombastic. [earlier *bombace* < MF < ML *bombace(m)*,

acc. of *bombaz* cotton; see BOMBACACEOUS]

bom-bastic (bom bas'tik), *adj.* (of speech, writing, etc.)

high-sounding; high-flown; inflated; pretentious. Also,

bom-bas'tic; *bom-bas'tic-ally*, *adv.*

Bom-bay (bom bā'), n. 1. a seaport in and the capital of

Maharashtra, in W India, on the Arabian Sea. 4,537,926

(est. 1964). 2. a former state in W India; divided in 1960

into the Gujarat and Maharashtra states.

bom-bazine (bom/bā zān', bom/bā zān'), n. a twill

fabric constructed of a silk or rayon warp and worsted

filling, often dyed black for mourning wear. Also, *bom/-*

ba-sine', *bom/bā-zeen'*. [earlier *bombazin* < MF < ML

bombazin(um), var. of LL *bombycinum*, n. use of neut. of

bombycinus silken = L *bombyc-* (s. of *bombyz* silk, silkworm

< Gk) + *-inus -ine*]

bomb' bay', *Aeron.*, *Mil.* (in the fuselage of a bomber)

the compartment in which bombs are carried and from

which they are dropped.

bombe (bom, bom; *Fr.*

bōmb), n., pl. **bombes** (bomz,

bombz; *Fr.* bōnb), a round

or melon-shaped frozen mold

made from a combination of

ice creams, mousses, or ices.

[*< F*: lit., BOMB, i.e., ball,

from its shape]

bom-bé (bom bā'; *Fr.* bon-

bā'), *adj.* Furniture, curving

or swelling outward. Cf.

swell front. [*< F*: lit.,

rounded like a bomb =

bombe BOMB + *-é* *adj.* suffix

< L *-āus -ate*]

bom-bér (bom/er), n. *Mil.*

an airplane equipped to carry

and drop bombs.

bomb-load (bom/lo'd), n.

the total load of bombs car-

ried by an airplane, usually expressed in terms of their total

weight.

bomb-proof (bom/proōf'), *adj.* 1. able to withstand the

impact of bombs. —n. 2. a bombproof structure.

bomb' run', *Mil.* the part of a bombing mission between

the sighting of the target and the release of the bombs. Also,

bomb'ing run'.

bomb-shell (bom/shel'), n. 1. a bomb. 2. something or

someone that has a sudden and sensational effect.

a filling of fruit jam. [*< F*: lit., good-good; a repetitive

compound, orig. nursery word]

bon-bonnière (bōn bō nyēr'), n., pl. **-nières** (-nyēr'):

1. a confectioner's store. 2. (italics) French, a box or dish

for candies. [*< F*: lit., candy-holder]

bond' (bond), n. 1. something that binds, fastens, or con-

nects. 2. a cord or rope for tying something. 3. something

that binds a person or persons to a certain behavior: the bond

of matrimony. 4. something, as an agreement, that unites

individuals or peoples; covenant: the bond between nations.

5. binding security; firm assurance: My word is my bond.

6. a sealed instrument under which a person, corporation,

or government guarantees to pay a stated sum of money

on or before a specified day. 7. Law, a written promise of

a surety of the amount assured. Cf. bail. 8. Govt. the

state of dutiable goods stored under a bond in charge of the

government: goods in bond. 9. Also called **bonded whiskey**,

U.S. a whiskey that has been aged at least four years in a

bonded warehouse before bottling. 10. Finance, a certificate

of ownership of a specified portion of a debt due to be paid

by a government or corporation to an individual holder and

usually bearing a fixed rate of interest. 11. Insurance, a

surety agreement. b. the money deposited, or the promis-

sory arrangement entered into, under any such agreement.

12. a substance that causes particles to adhere; binder.

13. adhesion between two substances or objects. 14. Chem.

the attraction between atoms in a molecule. 15. See **bond**

paper. 16. Masonry, a. any of various arrangements of

bricks, stones, etc., having a regular pattern and intended

to increase the strength or enhance the appearance of a con-

struction. b. the overlap of bricks, stones, etc., in a con-

struction so as to increase its strength. 17. Obs. bondsman.

—*v.t.* 18. to put (goods, an employee, etc.) on or under bond.

19. to connect or bind. 20. Finance, to place a bonded debt

on or secure a day (by bricks, stones, etc.) so as to produce a

strong construction. —*v.t.* 23. to hold together or cohere,

as bricks in a wall or particles in a mass. [ME; var. of

bandz] —**bond'er**, n.

—*Syn.* 1. chains, fetters. 3. BOND, LINK, TIE agree in refer-

ring to a force or influence that unites people. BOND, how-

ever, usually emphasizes the strong and enduring quality

of affection, whereas tie may refer more esp. to duty, obli-

gation, or responsibility: bonds of memory; Blessed be the tie

that binds; family ties. A link is a definite connection, though

a slighter one; it may indicate affection or merely some trace-

able influence or desultory communication: a close link be-

tween friends.

bondz (bond) *adj.* Obs. in serfdom or slavery. [ME *bond(e)*,

OE *bōnda* < Scand; cf. Icel *bōndi* husband(MAN), contr. of

bōunda, var. of *būanda*, c. OE *būend* dweller = *bū(an)* (to)

dwell (see *BOOR*) + *-end* n. suffix, as in *fiend*, *friend*.]

Bond (bond), n. Songwriter and author.

1862-1946, U.S. songwriter and author.

bond-age (bon/dij), n. 1. slavery or involuntary servitude;

serfdom. 2. the state of being bound by or subjected to

external control. 3. Early Eng. Law, personal subjection to

the control of a superior; vassalage. 4. thralldom, captivity.

—*Syn.* 1. captivity. See slavery. 2. thralldom, captivity.

bond-ed (bon/did), *adj.* 1. secured by or consisting of

bonds: *bonded debt*. 2. placed in bond: *bonded goods*.

bond'ed ware/house, a warehouse for goods held in

bond by the government.

bond'ed whis/key, *bond'* (def. 9).

bond-holder (bond/hol'er), n. a holder of a bond or

—*bon'd-*

fol. by up): She's boning up for her finals. [MF

bān; c. D been bone, leg. Icel bein bone, G Bein leg

less, *adj.*

Bōne (bōn'), n. former name of Annaba.

bone' ash', n. the remains of bones calcined

used as a fertilizer and in the making of bone

called **bone' earth'**.

bone-black (bon/blak'), n. a black, carbon-